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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,515	10/07/2004	Guglielmo Biagiotti	6390/PCT	8896
6858	7590	01/02/2008	EXAMINER	
BREINER & BREINER, L.L.C. P.O. BOX 320160 ALEXANDRIA, VA 22320-0160			MACKEY, JAMES P.	
ART UNIT		PAPER NUMBER		
1791				
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01/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/510,515	BIAGIOTTI ET AL.
Examiner	Art Unit	
James Mackey	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 October 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 11-14 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 11-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 October 2007 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Riemersma et al. (U.S. Patent 4,272,473; Figure 1).

Riemersma et al. teach an embossing apparatus comprising a first rigid cylinder 17 having a smooth surface (of steel, col. 6, lines 32-33) and a second rigid cylinder 13 (of steel, col. 5, lines 44 and 53-55) having protuberances 16, 26 (col. 5, lines 19-21), the first and second cylinders defining a first nip therebetween, a pressure roller 18 having a resilient surface provided by a rubber coating 44 (col. 7, lines 28-30) that is less rigid than said first and second cylinders, the pressure roller and the second cylinder defining a second nip therebetween which is downstream of the first nip, means 41 for pressing the first cylinder and the second cylinder against each other, and means 47 for pressing the pressure roller and the second cylinder against each other. Note that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz (U.S. Patent 5,091,032; Figure 3) in view of Lefebvre Du Grosriez (U.S. Patent 6,475,346; Figure 1).

Schulz discloses an embossing apparatus (Figure 3) comprising a first rigid cylinder 46 and a second rigid cylinder 48 having protuberances (col. 4, lines 45-49), the first and second

cylinders defining a first nip 52 therebetween, a pressure roller 50 having a resilient rubber surface that is less rigid than said first and second cylinders (col. 4, lines 50-55), the pressure roller and the second cylinder defining a second nip 49 therebetween which is downstream of the first nip. Schulz inherently discloses means for pressing the first cylinder and the second cylinder against each other and means for pressing the pressure roller and the second cylinder against each other (note col. 4, line 61, and col. 5, lines 11-12). Schulz does not disclose that the first rigid cylinder has a smooth surface, does not disclose the protuberances of the second cylinder being arranged in longitudinal bands parallel to the cylinder axis and circumferential annular bands, and does not disclose that the resilient surface of the pressure roll is provided by a rubber coating. However, the use of a rigid embossing cylinder cooperating with a rigid smooth cylinder was well known and conventional in the embossing art for simultaneously embossing and joining two web plies, as evidenced by Lefebvre Du Grosriez (see especially col. 5, lines 57-67), and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Schulz by providing the first rigid cylinder with a smooth surface cooperating with the embossing surface of the second rigid cylinder since such were equivalent means for embossing and joining two webs. With regard to the protuberances of the second cylinder being arranged in longitudinal and circumferential bands, such is a known arrangement of embossing protuberances as disclosed in Lefebvre Du Grosriez, and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Schulz by providing the second embossing cylinder with such a known arrangement of embossing protuberances in order to form desired embossments in the product web, as suggested by Lefebvre Du Grosriez. With regard to the pressure roller having a rubber coating, it would have been obvious to a skilled artisan to

have provided the resilient rubber surface of the pressure roller of Schulz as a rubber coating, as is conventional in the embossing art, in order to facilitate the manufacture of the pressure roller. Note that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235.

7. Claims 12 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Riemersma et al. in view of Lefebvre Du Grosriez (U.S. Patent 6,475,346; Figure 1).

Riemersma et al. disclose the embossing apparatus substantially as claimed, except for the protuberances of the second cylinder being arranged in longitudinal bands parallel to the cylinder axis and circumferential annular bands. However, such is a known arrangement of embossing protuberances as disclosed in Lefebvre Du Grosriez, and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Riemersma et al. by providing the second embossing cylinder with such a known arrangement of embossing protuberances in order to form desired embossments in the product web.

8. Applicant's arguments filed 16 October 2007 have been fully considered but they are not persuasive.

Applicants' arguments concerning WO 00/73053, specifically regarding the non-obviousness of modifying the first cylinder to be smooth, and also the lack of disclosure of

contact between the protuberances 28 of the second cylinder and the surface of the first cylinder, are persuasive. The rejections based on WO 00/73053 have been withdrawn based on the arguments of record and the claim amendments.

Applicant argues that Riemersma et al. is not directed to joining of two layers and therefore is not relevant to the claimed device. However, Riemersma et al. teach each of the structural elements of the claimed device. Moreover, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647; purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666; the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235.

Applicant argues that Riemersma et al. teach that a resilient pressure roller 15 is arranged upstream of the nip between the first and second cylinders. However, a resilient pressure roller 18 is arranged downstream of the nip between the first and second cylinders as claimed. Note that an additional upstream pressure roller is not precluded by the instant claims.

Applicant argues that it would not have been obvious to modify Schulz by providing the first rigid cylinder 46 with a smooth surface. However, Lefebvre Du Grosriez explicitly discloses (col. 5, lines 57-67) that such an arrangement is known in the art for simultaneous joining and embossing (marking) of two web plies.

Applicant argues that there is no mutual contact or pressure between the first and second cylinders of Schulz. However, Schulz explicitly refers to the nip pressures in the first and second nips 52, 49 (note col. 4, line 61, and col. 5, lines 11-12), and thus inherently, if not explicitly, discloses mutual contact or pressure between the first and second cylinders at the first nip 52.

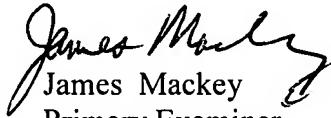
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
James Mackey  
Primary Examiner  
Art Unit 1791

jpm  
December 27, 2007

12/27/07